

**REMARKS**

**INTRODUCTION**

In accordance with the foregoing, claims 1, 2, 12 and 13 have been amended. Claim 3 has been cancelled. No new matter is being presented, and approval and entry are respectfully requested.

Claims 1, 2, and 4-13 are pending and under consideration. Reconsideration is respectfully requested.

**ENTRY OF RESPONSE UNDER 37 C.F.R. §1.116**

Applicants request entry of this Rule 116 Response and Request for Reconsideration because:

(a) at least certain of the rejected claims have been canceled thereby at least reducing the issues for appeal;

(b) the amendments of claims 1, 2, 12, and 13 should not entail any further search by the Examiner since no new features are being added or no new issues are being raised; and

(c) the amendments do not significantly alter the scope of the claims and place the application at least into a better form for appeal. No new features or new issues are being raised; and/or

(d) at least one of the references applied to the claims is newly cited in the final Office Action, and Applicants should be provided the opportunity to present patentability arguments and amendments in view thereof.

The Manual of Patent Examining Procedures sets forth in §714.12 that "[a]ny amendment that would place the case either in condition for allowance or in better form for appeal may be entered." ( Underlining added for emphasis) Moreover, §714.13 sets forth that "[t]he Proposed Amendment should be given sufficient consideration to determine whether the claims are in condition for allowance and/or whether the issues on appeal are simplified." The Manual of Patent Examining Procedures further articulates that the reason for any non-entry should be explained expressly in the Advisory Action.

**REJECTION OF CLAIMS 1-4 AND 11-13 UNDER 35 U.S.C. § 103(a)**

In the final Office Action at page 2, numbered items 5-13, claims 1, 2, 4, 12, and 13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,393,460 to Gruen (hereinafter Gruen) in view of newly-cited U.S. Patent No. 5,982,369 to Sciammarella, et al. (hereinafter Sciammarella). In the final Office Action at page 6, numbered items 14-20, claims 3 and 11 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Gruen and the newly-cited Sciammarella in view of U.S. Patent No. 6,564,244 to Ito, et al. (hereinafter Ito). These rejections are traversed and reconsideration is respectfully requested.

Amended independent claims 1, 2, 12, and 13 each include similar features to those of cancelled previously examined claim 3, and recite "the chat volume is recorded during a period of time after a message including at least one of the keywords is sent in the virtual space," in which "the recorded chat volume is proportional to an amount of interest of at least one user participating in the virtual space in response to the message including the at least one of the keywords," and in which "the virtual space characteristics are calculated based on at least the recorded chat volume," support for which is found in the originally filed specification at least in claim 3 and at page 7, line 12 to page 8, line 7.

As an advantage, in a non-limiting example, when a user posts a message containing a keyword, the level of interest of other users in response to the message containing the keyword may be reflected in the number of posts made by the other users during a period of time following the posting of the message containing the keyword. That is, if the user posts a message containing a highly relevant keyword, it may be expected that a higher chat volume will be observed in the virtual space for a period of time immediately following the posting of the message containing the relevant keyword. By the same token, a posted message containing keywords which are irrelevant to the virtual space may be expected to generate a lower chat volume for the time immediately following the posting of the message containing the relevant keyword. Therefore, the relevance of a keyword contained in a posted message may be inferred from the chat volume recorded following the message (see Specification at page 7, line 18 to page 8, line 7).

In contrast, as acknowledged by the Examiner in the outstanding Office Action at page 6, item 17, "Gruen and Sciammarella did not teach the step of said control means and the step of said decision means includes said keyword message times." Further, Ito at col. 3, lines 47-55

only discusses a **frequency of occurrence** of a keyword entered in a search system. It is respectfully submitted that recording the frequency of occurrence of a keyword is different from "a chat volume . . . recorded during a period of time after a message including at least one of the keywords is sent into virtual space," in which "the recorded chat volume is proportional to an amount of interest of at least one user participating in the virtual space in response to the message including the at least one of the keywords," as recited in amended independent claims 1, 2, 12, and 13. Accordingly, it is respectfully submitted that amended independent claims 1, 2, 12, and 13 patentably distinguish over Gruen, Sciammarella, and Ito. As claims 4 and 11 depend directly from claim 2, Applicants respectfully submit that claims 4 and 11 patentably distinguish over Gruen, Sciammarella, and Ito for at least the same reasons as independent claim 2. Thus, Applicants respectfully submit that claims 1, 2, 4, and 11-13 are in condition for allowance.

#### **REJECTION OF CLAIM 5 UNDER 35 U.S.C. § 103(a)**

In the final Office Action at page 8, numbered items 21-24, claim 5 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Gruen and newly-cited Sciammarella in view of U.S. Patent No. 6,425,012 to Trovato, et al. (hereinafter Trovato). This rejection is traversed and reconsideration is respectfully requested.

As claim 5 depends directly from independent claim 2, Applicants respectfully submit that claim 5 patentably distinguishes over Gruen and Sciammarella for at least the same reasons as independent claim 2, as set forth above. Thus, Applicants respectfully submit that claim 5 is also in condition for allowance.

#### **REJECTION OF CLAIM 6 UNDER 35 U.S.C. § 103(a)**

In the final Office Action at page 9, numbered items 25-28, claim 6 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Gruen and newly-cited Sciammarella in view of U.S. Patent No. 5,941,947 to Brown, et al. (hereinafter Brown). This rejection is traversed and reconsideration is respectfully requested.

As claim 6 depends directly from independent claim 2, Applicants respectfully submit that claim 6 patentably distinguishes over Gruen and Sciammarella for at least the same reasons as independent claim 2, as set forth above. Thus, Applicants respectfully submit that claim 6 is also in condition for allowance.

### **REJECTION OF CLAIM 7 UNDER 35 U.S.C. § 103(a)**

In the final Office Action at page 10, numbered items 29-32, claim 7 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Gruen and newly-cited Sciammarella in view of U.S. Patent No. 6,065,056 to Bradshaw, et al. This rejection is traversed and reconsideration is respectfully requested.

As claim 7 depends directly from independent claim 2, Applicants respectfully submit that claim 7 patentably distinguishes over Gruen and Sciammarella for at least the same reasons as independent claim 2, as set forth above. Thus, Applicants respectfully submit that claim 7 is also in condition for allowance.

### **REJECTION OF CLAIMS 8-10 UNDER 35 U.S.C. § 103(a)**

In the final Office Action at page 11, numbered items 33-36, claims 8-10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Gruen, newly-cited Sciammarella and Bradshaw in view of U.S. Patent No. 6,076,100 to Cottrille, et al. This rejection is traversed and reconsideration is respectfully requested.

As claims 8-10 depend indirectly from independent claim 2, Applicants respectfully submit that claims 8-10 patentably distinguish over Gruen and Sciammarella for at least the same reasons as independent claim 2, as set forth above. Thus, Applicants respectfully submit that claims 8-10 are also in condition for allowance.

### **CONCLUSION**

In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot. And further, that all pending claims patentably distinguish over the prior art. Thus, there being no further outstanding objections or rejections, the application is submitted as being in condition for allowance which action is earnestly solicited.

If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited by the Examiner contacting the undersigned attorney for a telephone interview to discuss resolution of such issues.

Serial No. 09/666,859

If there are any underpayments or overpayments of fees associated with the filing of this Amendment, please charge and/or credit the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date:

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By:

David M. Pitcher

David M. Pitcher

Registration No. 25,908

1201 New York Avenue, NW, Suite 700  
Washington, D.C. 20005  
Telephone: (202) 434-1500  
Facsimile: (202) 434-1501